

Traverse of the Restriction Requirement

The remaining issue as to the first restriction requirement is whether the apparatus as claimed in claim 1 can be used to practice a method materially different from that in claim 11. MPEP section 805.05(c) expresses the standard for finding process and apparatus for its practice to be distinct:

Process and apparatus for its practice can be shown to be distinct inventions, if either or both of the following can be shown: (A) that the process *as claimed* can be practiced by another materially different apparatus or by hand; or (B) that the apparatus *as claimed* can be used to practice another and materially different process. (emphasis in the original)

The Examiner asserts that “the cue may be used without an icon to line up a shot as is done with any pool cue” (FOA, page 2, ¶1). Applicants respectfully submit that the Examiner’s assertion is mistaken on the facts. The Examiner’s argument appears to ignore either the “as claimed” language of the standard or the elements of claim 11, which include:

- a) establishing a line of sight from a cue ball to an object ball;
- b) aiming a pool shot, and
- c) observing with peripheral vision the at least one icon having a predetermined distance related to a game parameter while stroking the pool cue shot. (App. Claim 11, emphasis added)

The apparatus as claimed includes the element of a pool cue system comprising “at least one icon appearing on the exterior surface of the pool cue shaft observable within a user’s peripheral vision when the pool cue shaft is in use” (App. Claim 1, emphasis added).

The Examiner has not revealed how a user who has “at least one icon ... observable within a user’s peripheral vision when the pool cue shaft is in use” (included in the apparatus as claimed, App. Claim 1) can avoid “observing with peripheral vision the at least one icon ... while stroking the pool cue shot” (App. Claim 11). The method claim 11 does not require the user to concentrate on the icons, calculate factors regarding the icons, or focus attention on the icons (although these options exist, and may be useful); claim 11 merely requires that the user observe the icon with the peripheral vision, which happens automatically as a property of human vision when and only when the pool

Application No. 10/949,868

Request for Withdrawal of Final Office Action and, in the Alternative, Response to Final Office Action

cue has "at least one icon ... observable within a user's peripheral vision when the pool cue shaft is in use" (App. Claim 1). Applicants respectfully submit that it is actually impossible to use the pool cue apparatus as claimed in claim 1 in a process that is a materially different process from the process as claimed in claim 11. Applicants respectfully submit that the restriction requirement should be withdrawn.

Traverse of the 102(b) Rejection of Claims 1-3, 5, 6, 9 and 10 based upon Gibney

Applicants respectfully submit that the Examiner's arguments contained in the Final Office Action pertaining to Gibney are unresponsive as to the last element in applicants' claim 1. In regard to the grounds for rejection repeated from the First Office Action, applicants respectfully submit that Gibney nowhere expressly discloses the "predetermined distance axially along the pool cue shaft from the ferrule-receiving portion of said pool cue shaft; and said at least one predetermined distance has a relationship to at least one game parameter" (claim 1) or any equivalent thereto. Applicants respectfully submit that the Examiner has implicitly admitted this by resort to an inherency argument. For the reasons discussed below, applicants respectfully submit that Gibney does not inherently disclose that "said at least one predetermined distance has a relationship to at least one game parameter" (claim 1).

Law and Rules

An inherency argument requires a showing that the undisclosed element necessarily results from the reference, not merely that the undisclosed element is possible or probable. MPEP 2112(IV) provides in relevant part: "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic"; *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. (emphasis added); *In re Robinson*, 169 F.3d 743, 49 USPQ2d 1949 (Fed. Cir. 1999) (probability and possibility are not sufficient to establish inherency); *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) ("In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." (emphasis in original); *Scaltech Inc. v. Retec/Tetra, L.L.C.*, 156 F.3d 1193, 48 USPQ2d 1037 (Fed. Cir. 1998), *revised and reissued*, 178 F.3d 1378, 1384, 51 USPQ2d 1055,

1059 (Fed. Cir. 1999)(as revised subsequent to *Pfaff* (1999) (“Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency.”); *Munising Paper Co. v. American Sulphite Pulp Co.*, 228 F. 700, 703-03 (6th Cir. 1915) (“[A]nticipation is not disclosed by a drawing which incidentally shows a similar arrangement of parts, where such arrangement is not essential to the first invention and was not designed, adapted, and used to perform the function which it performs in the second invention, and where the first patent contains no suggestion of the way in which the result sought is accomplished by the second invention.”); *James River Corp. of Virginia v. Hallmark Cards, Inc.*, 915 F. Supp 968, 1000 (E.D. Wis. 1996) (“the on sale bar does not apply to accidental, unintended, and unappreciated sales or uses.”); *Transclean Corp. v. Bridgewood Services, Inc.*, 290 F.3d 1364, 1373, 62 USPQ2d 1865 (Fed. Cir. 2002)(“anticipation by inherent disclosure is appropriate only when the reference discloses prior art that must *necessarily* include the unstated limitation...”)).

Argument

Applicants respectfully submit that the Examiner has not shown that the distance between Gibney’s alleged icons and the ferrule-receiving portion of the shaft necessarily has a relationship to a game parameter or even that such a distance necessarily exists. The Examiner has argued (Interview Summary) that the icons in the disclosure of Gibney inherently anticipate the last element of applicants’ claim 1. However, the distance between the ferrule-receiving portion of the cue shaft and the alleged icons of Gibney does not necessarily relate to a game parameter (*MPEP 2112(IV)*; *In re Robinson, supra*; *Ex parte Levy, supra*; *In re Oelrich, supra*; *Scaltech Inc. v. Retec/Tetra, L.L.C., supra*; *James River Corp. of Virginia v. Hallmark Cards, Inc., supra*; *Transclean Corp. v. Bridgewood Services, Inc., supra*). Applicants respectfully submit that visibility is not a game parameter by virtue of being separated from game parameters into separate elements of claim 1. The first element of claim 1 concerns visibility of the icon, the last element concerns game parameters. The Examiner has made no objection to claim 1 based upon redundant claim language. Accordingly, applicants respectfully submit that the Examiner has already recognized a distinction between visibility and game parameters. Gibney discloses that the distance is related to a non-game parameter:

visibility of the alleged icon (Gibney, Page 2, ¶1, ¶3). This relationship does not touch upon the last element of applicants' claim 1. Because the distance between the icons of Gibney and the ferrule-receiving portion of the pool cue shaft does not necessarily have a relationship to a game parameter, Gibney does anticipate every element of claim 1 and no prima facie case of anticipation lies.

Indeed, Gibney discloses that there may be no distance at all between the ferrule-receiving portion of the pool cue shaft and the icon where he discloses "a small visible part close to the cue tip, conveniently just below any ferrule for the tip itself but feasibly also on or extending onto such ferrule" (Gibney, page 2, lines 14-16, emphasis added). Applicants respectfully submit that when the alleged icon extends onto the ferrule, there is no "at least one icon ... located at least one predetermined distance axially along the pool cue shaft from the ferrule-receiving portion of said pool cue shaft" (App. Claim 1, see also exemplary distance 312 in FIG. 3). Applicants further respectfully submit that Gibney's FIG. 1 shows Gibney's icons 14 touching the edge of Gibney's ferrule-receiving portion, indicating that there is no "at least one predetermined distance axially along the pool cue shaft from the ferrule-receiving portion of said pool cue shaft" (Applicants' claim 1, *contrast* Gibney, FIG. 1, FIG. 2, and page 3, lines 9-11. Where a predetermined distance between the ferrule and the icon does not necessarily exist, the relationship between Gibney's optional distance and a game parameter cannot be necessary to Gibney's invention. Accordingly, no prima facie case of anticipation by inherency can lie based on Gibney. Applicants respectfully request that the Examiner withdraw the rejections of applicants' claims.

In the Interview Summary provided by the Examiner, the Examiner states that "the marks of Gibney and Preast were capable of being used as claimed and therefore inherently met the limitations as to icon limitations" (emphasis added). Applicants respectfully submit that "capable" speaks to possibility or probability, not necessity. (MPEP 2112(IV); *In re Robinson, supra*; *Ex parte Levy, supra*; *In re Oelrich, supra*; *Scaltech Inc. v. Retec/Tetra, L.L.C., supra*; *James River Corp. of Virginia v. Hallmark Cards, Inc., supra*; *Transclean Corp. v. Bridgewood Services, Inc., supra*). Accordingly, the Examiner's inherency argument is not supported, but contradicted, by the Examiner's argument. Accordingly, no prima facie case of inherency has been presented. Absent a

prima facie case of inherency for the last element of claim 1, a prima facie case of anticipation cannot lie. Applicants respectfully request that the Examiner withdraw the anticipation rejections of applicants' claims.

Applicants respectfully submit that no prima facie case of anticipation by express disclosure can lie based upon Gibney because, as the Examiner has implicitly admitted by resorting to an inherency argument, Gibney does not expressly disclose all elements of applicants' claims. All of applicants' arguments made on this point in Response to the First Office Action are included herein by reference. Accordingly, applicants respectfully request that the Examiner withdraw the rejections, which were allegedly based on anticipation by Gibney, of claims 1-3, 5, 6, 9, and 10.

Claim 2

Gibney does not expressly disclose "wherein said at least one predetermined distance further relates to at least one pool cue shaft property" (App. Claim 2). Arguments made above in this section regarding the lack of necessity of a predetermined distance between Gibney's alleged icon and the ferrule-receiving portion of the shaft in the invention of Gibney and the subsequent (and also independent) lack of inherency of icons defining predetermined distances having a relationship to a game parameter are incorporated here by reference. Accordingly, the Gibney reference does not disclose all elements of claim 2 and so cannot anticipate applicants' claim 2. Applicants respectfully request that the Examiner withdraw the rejection of claim 2.

Claim 3

Gibney does not expressly disclose "wherein said at least one predetermined distance further relates to at least one external factor" (App. Claim 3). Arguments made above in this section regarding the lack of necessity of a predetermined distance between Gibney's alleged icon and the ferrule-receiving portion of the shaft in the invention of Gibney and the subsequent (and also independent) lack of inherency of icons defining predetermined distances having a relationship to a game parameter are incorporated here by reference. Accordingly, the Gibney reference does not disclose all elements of claim 3 and so cannot anticipate applicants' claim 3. Applicants respectfully request that the Examiner withdraw the rejection of claim 3.

Claim 5

Request for Withdrawal of Final Office Action and, in the Alternative, Response to Final Office Action

Gibney does not expressly disclose "wherein said at least one icon comprises at least one icon disposed circumferentially about said pool cue shaft" as amended (App. Claim 5). An alleged icon of Gibney is not inherently circumferentially disposed about said pool shaft (Gibney, Page 6, lines 9-22). Arguments made above in this section regarding a predetermined distance between Gibney's alleged icon and the ferrule-receiving portion of the shaft in the invention of Gibney and the subsequent (and also independent) lack of inherency of icons defining predetermined distances having a relationship to a game parameter are included herein by reference. Accordingly, the Gibney reference does not disclose all elements of claim 5 and so cannot anticipate applicants' claim 5. Applicants respectfully request that the Examiner withdraw the rejection of claim 5.

Claim 6

Gibney does not expressly disclose "wherein said at least one icon comprises at least one feature of at least one larger iconic design" (App. Claim 6). An alleged icon of Gibney is not inherently a feature of a larger iconic design (Gibney, Page 6, lines 9-22). Arguments made above in this section regarding a predetermined distance between Gibney's alleged icon and the ferrule-receiving portion of the shaft in the invention of Gibney and the subsequent (and also independent) lack of inherency of icons defining predetermined distances having a relationship to a game parameter are included herein by reference. Accordingly, the Gibney reference does not disclose all elements of claim 6 and so cannot anticipate applicants' claim 6. Applicants respectfully request that the Examiner withdraw the rejection of claim 6.

Claim 9

Gibney does not expressly disclose "wherein said at least one game parameter is related to at least one stroke parameter" (App. Claim 9). Arguments made above in this section regarding a predetermined distance between Gibney's alleged icon and the ferrule-receiving portion of the shaft in the invention of Gibney and the subsequent (and also independent) lack of inherency of icons defining predetermined distances having a relationship to a game parameter are included herein by reference. Stroke parameters include stroke speed, stroke length, and bridge hand location. Accordingly, the Gibney reference does not disclose all elements of claim 9 and so cannot anticipate applicants'

claim 9. Applicants respectfully request that the Examiner withdraw the rejection of claim 9.

Claim 10

Gibney does not expressly disclose “wherein said at least one icon is located at least one predetermined distance axially along the pool cue shaft from the ferrule-receiving portion of said pool cue shaft; and said at least one predetermined distance has a relationship to at least one game parameter (App. Claim 1) wherein the pool cue shaft is integral to a pool cue stick” (App. Claim 10). Arguments made above in this section regarding a predetermined distance between Gibney’s alleged icon and the ferrule-receiving portion of the shaft in the invention of Gibney and the subsequent (and also independent) lack of inherency of icons defining predetermined distances having a relationship to a game parameter are included herein by reference. Accordingly, the Gibney reference does not disclose all elements of claim 10 and so cannot anticipate applicants’ claim 10. Applicants respectfully request that the Examiner withdraw the rejection, which was allegedly based on anticipation by Gibney, of claim 10.

Accordingly, applicants respectfully request that the Examiner withdraw the rejections of dependent claims 2, 3, 5, 6, 9, and 10 as anticipated by Gibney both for their own merits and for their dependency on allowable claim 1.

Traverse of the 102(b) Rejection of Claims 1-6, 9 and 10 based upon Preast

Applicants respectfully submit that the Examiner's arguments contained in the Final Office Action pertaining to Preast are unresponsive as to the last element in applicants' claim 1. For the reasons discussed below, applicants respectfully submit that Gibney does not inherently disclose that "said at least one predetermined distance has a relationship to at least one game parameter" (claim 1). In regard to the grounds for rejection repeated from the First Office Action, applicants respectfully submit that Preast does not expressly disclose the "predetermined distance axially along the pool cue shaft from the ferrule-receiving portion of said pool cue shaft; and said at least one predetermined distance has a relationship to at least one game parameter" (claim 1) or any equivalent thereto. The Examiner has implicitly admitted this by resort to an inherency argument. Applicants include herein by reference all arguments made in response to the Examiner's rejections in the First Office Action.

Law and Rules

An inherency argument requires a showing that the undisclosed element necessarily results from the reference, not merely that the undisclosed element is possible or probable. MPEP 2112(IV) provides in relevant part: "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic"; *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. (emphasis added); *In re Robinson*, 169 F.3d 743, 49 USPQ2d 1949 (Fed. Cir. 1999) (probability and possibility are not sufficient to establish inherency); *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) ("In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." (emphasis in original); *Scaltech Inc. v. Retec/Tetra, L.L.C.*, 156 F.3d

Request for Withdrawal of Final Office Action and, in the Alternative, Response to Final Office Action

1193, 48 USPQ2d 1037(Fed. Cir. 1998), *revised and reissued*, 178 F.3d 1378, 1384, 51 USPQ2d 1055, 1059 (Fed. Cir. 1999)(as revised subsequent to *Pfaff* (1999) (“Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency.”); *Munising Paper Co. v. American Sulphite Pulp Co.*, 228 F. 700, 703-03 (6th Cir. 1915) (“[A]nticipation is not disclosed by a drawing which incidentally shows a similar arrangement of parts, where such arrangement is not essential to the first invention and was not designed, adapted, and used to perform the function which it performs in the second invention, and where the first patent contains no suggestion of the way in which the result sought is accomplished by the second invention.”); *James River Corp. of Virginia v. Hallmark Cards, Inc.*, 915 F. Supp 968, 1000 (E.D. Wis. 1996) (“the on sale bar does not apply to accidental, unintended, and unappreciated sales or uses.”); *Transclean Corp. v. Bridgewood Services, Inc.*, 290 F.3d 1364, 1373, 62 USPQ2d 1865 (Fed. Cir. 2002)(“anticipation by inherent disclosure is appropriate only when the reference discloses prior art that must *necessarily* include the unstated limitation...”).

Argument

Because the use of differently colored wooden laminates is not necessary in the invention of Preast, Preast does not inherently anticipate applicant's claims. The Examiner has argued that the different colors of wood in the disclosure of Preast form icons that anticipate applicants' claim 1 (OA, page 4, FOA page 3, Interview Summary of Examiner). The allegedly inherent element is disclosed in the last two lines of applicants' claim 1: “said at least one predetermined distance has a relationship to at least one game parameter.” However, different colors of wood are not necessary for the invention of Preast, but only preferred, (Preast, Col. 1, lines 10-11). (MPEP 2112(IV); *In re Robinson, supra*; *Ex parte Levy, supra*; *In re Oelrich, supra*; *Scaltech Inc. v. Retec/Tetra, L.L.C., supra*; *James River Corp. of Virginia v. Hallmark Cards, Inc., supra*; *Transclean Corp. v. Bridgewood Services, Inc., supra*). Preast does not claim differently colored woods, further indicating that differently colored woods are not necessary to the invention. In a patent directed to “an improved construction of pool or billiard cue” (Preast, Col. 1, lines 8-9) Preast discloses using different colored woods to “present a pleasing appearance” (Preast, Col 2, lines 86-87) while describing one

Request for Withdrawal of Final Office Action and, in the Alternative, Response to Final Office Action

particular embodiment of the invention. Applicants respectfully submit that, where the alleged icons of Preast do not necessarily exist, the predetermined distance between such unnecessary (and sometimes non-existent) icons and the ferrule-receiving portion of the shaft cannot necessarily have a relationship to a game parameter. Accordingly, Preast cannot inherently anticipate the last element of applicants' claim 1. Because Preast does not anticipate every element of applicants' claim 1, a prima facie case of anticipation cannot lie. Accordingly, applicants respectfully request that the Examiner withdraw the rejection of applicants' claims.

Applicants respectfully submit that the drawing of Preast (FIG. 1) incidentally shows an arrangement of marks along the shaft of the pool cue, which is not essential to Preast's invention and was not disclosed as being designed, adapted, and used to perform the function which it performs in applicants' claim 1 (*Munising Paper Co. v. American Sulphite Pulp Co.*, *supra*). Furthermore, applicants respectfully submit that Preast contains no suggestion of the way in which applicants' result sought is accomplished. *Ibid.* Even in the case where woods of different colors are used by Preast, applicants respectfully submit that the positioning of Preast's alleged icons is the result of the interaction of the thickness of the laminae and the taper of the cue shaft (Preast, Col. 1, lines 42-48). Preast does not specify a thickness for laminae nor a taper for the shaft and so does not predetermine a distance between any alleged icon and the ferrule-receiving portion of the shaft. Preast never relates the positioning of the alleged icons to any game parameter or to any other use than the production of a pleasing appearance (Preast, Col. 1, line 15; Col. 2, line 87). Accordingly, applicants respectfully submit that no prima facie case of anticipation by inherency may be based upon the FIG. 1 in Preast.

Applicants respectfully submit that no prima facie case of anticipation by express disclosure can lie based upon Preast because, as the Examiner has implicitly admitted by resorting to an inherency argument, Preast does not expressly disclose all elements of applicants' claims. Accordingly, applicants respectfully request that the Examiner withdraw the rejections, which were allegedly based on anticipation by Preast, of claims 1-6, 9, and 10.

In the Interview Summary provided by the Examiner, the Examiner states that "the marks of Gibney and Preast were capable of being used as claimed and therefore

Request for Withdrawal of Final Office Action and, in the Alternative, Response to Final Office Action

inherently met the limitations as to icon limitations” (emphasis added). Applicants

respectfully submit that “capable” speaks to possibility or probability, not necessity.

(MPEP 2112(IV); *In re Robinson*, *supra*; *Ex parte Levy*, *supra*; *In re Oelrich*, *supra*; *Scaltech Inc. v. Retec/Tetra, L.L.C.*, *supra*; *James River Corp. of Virginia v. Hallmark Cards, Inc.*, *supra*; *Transclean Corp. v. Bridgewood Services, Inc.*, *supra*). Accordingly, the Examiner’s inherency argument is not supported, but contradicted, by the Examiner’s argument. Accordingly, no prima facie case of inherency has been presented. Applicants respectfully request that the Examiner withdraw the rejection of applicants claims.

Claim 2

Preast does not expressly disclose “wherein said at least one predetermined distance further relates to at least one pool cue shaft property” (App. Claim 2).

Arguments made above in this section regarding the lack of necessity of differently colored woods in the invention of Preast and the subsequent lack of inherency of icons defining predetermined distances are incorporated here by reference. Accordingly, the Preast reference does not disclose all elements of claim 2 and so cannot anticipate applicants’ claim 2. Applicants respectfully request that the Examiner withdraw the rejection of claim 2.

Claim 3

Preast does not expressly disclose “wherein said at least one predetermined distance further relates to at least one external factor” (App. Claim 3). Arguments made above in this section regarding the lack of necessity of differently colored woods in the invention of Preast and the subsequent lack of inherency of icons defining predetermined distances are incorporated here by reference. Accordingly, the Preast reference does not disclose all elements of claim 3 and so cannot anticipate applicants’ claim 3. Applicants respectfully request that the Examiner withdraw the rejection of claim 3.

Claim 4

Preast does not expressly disclose “wherein said at least one icon comprises two icons and said at least one predetermined distance comprises two distinct predetermined distances providing a distance between at least part of each icon of said two icons.” Arguments made above in this section regarding the lack of necessity of differently colored woods in the invention of Preast and the subsequent lack of inherency of icons

defining predetermined distances are incorporated here by reference. Accordingly, the Preast reference does not disclose all elements of claim 4 and so cannot anticipate applicants' claim 4. Applicants respectfully request that the Examiner withdraw the rejection of claim 4.

Claim 5

Preast does not expressly disclose "wherein said at least one icon comprises at least one icon disposed circumferentially about said pool cue shaft" as amended (App. Claim 5). An alleged icon of Preast is not inherently circumferentially disposed about said pool shaft. Accordingly, the Preast reference does not disclose all elements of claim 5 and so cannot anticipate applicants' claim 5. Applicants respectfully request that the Examiner withdraw the rejection of claim 5.

Claim 6

Preast does not expressly disclose "wherein said at least one icon comprises at least one feature of at least one larger iconic design" (App. Claim 6). An alleged icon of Preast, which does not inherently exist, is not inherently a "at least one feature of at least one larger iconic design" (App. Claim 6). Arguments made above in this section regarding the lack of necessity of differently colored woods in the invention of Preast and the subsequent lack of inherency of icons defining predetermined distances are incorporated here by reference. Accordingly, the Preast reference does not disclose all elements of claim 6 and so cannot anticipate applicants' claim 6. Applicants respectfully request that the Examiner withdraw the rejection of claim 6.

Claim 9

Preast does not expressly disclose "wherein said at least one game parameter is related to at least one stroke parameter" (App. Claim 9). Arguments made above in this section regarding the lack of necessity of differently colored woods in the invention of Preast and the subsequent lack of inherency of icons defining predetermined distances are incorporated here by reference. Stroke parameters include stroke length, stroke speed, and bridge hand location. Accordingly, the Preast reference does not disclose all elements of claim 9 and so cannot anticipate applicants' claim 9. Applicants respectfully request that the Examiner withdraw the rejection of claim 9.

Claim 10

Preast does not expressly disclose "wherein said at least one icon is located at least one predetermined distance axially along the pool cue shaft from the ferrule-receiving portion of said pool cue shaft; and said at least one predetermined distance has a relationship to at least one game parameter (App. Claim 1) wherein the pool cue shaft is integral to a pool cue stick" (App. Claim 10). Arguments made above in this section regarding the lack of necessity of differently colored woods in the invention of Preast and the subsequent lack of inherency of icons defining predetermined distances are incorporated here by reference. Accordingly, the Preast reference does not disclose all elements of claim 10 and so cannot anticipate applicants' claim 10. Applicants respectfully request that the Examiner withdraw the rejection of claim 10.

Accordingly, applicants respectfully request that the Examiner withdraw the rejections of dependent claims 2-6, 9, and 10 as anticipated by Preast both for their own merits and for their dependency on allowable claim 1.

Traverse of the 103(a) Rejection of Claim 8 over Williams in view of Holt

In the Final Office Action, the Examiner argues that “The predetermined distances in marking a cue such as taught by Holt, as with all of the icon marking, may be used to aim the cue. This is all that is required by the claims.” The phrase “aim the cue” does not appear in claim 8.

Law and Rules

To make a prima facie case of obviousness, the Examiner must meet three criteria. (MPEP 2142). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Applicants raised each of these issues in the Response to the First Office Action. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure.

Argument

Applicants respectfully submit that, in response to applicants raising the issue of motivation to combine in the applicants’ response to the First Office Action, the Examiner did not state a motivation for combining the references in the Final Office Action and so the Examiner has conceded the point.

Applicants respectfully submit that the Examiner may be overstating Williams (GB 2039368A) for placing trademarks on a cue where Williams only teaches and suggests placing label holders with labels on the butt of the cue (Williams, Spec. 1, lines 60-75, lines 94-97; Spec. 2, lines 31-35, lines 45-48; Claim 1). Applicants’ have not found the word “trademark” or the phrase “special marks” in the disclosure of Williams and request that the Examiner more specifically cite the source of these words as presented in the Final Office Action (FOA page 3). Applicants respectfully submit that Williams does not teach or suggest the placing of trademarks on pool cues and that Williams teaches away from putting trademarks on pool cues. Williams teaches labeling the goods of one manufacturer differently for each of 200 different retailers, which teaches away from trademarks because the labels may not identify the source of the

goods (i.e., the manufacturer) but rather, the retailer. (Williams, Spec. 1, lines 5-19).

Accordingly, Williams does not teach or suggest placing trademarks on pool cues and so has nothing to combine with Holt. Accordingly, a prima facie case of obviousness cannot lie from the combination of Williams and Holt, and the Examiner should allow claim 8.

Because Williams' label holder does not conform to the circumferential curvature of the cue surface but is, instead, flat (Williams FIGs. 1-5, Spec. 1, lines 76-93) it would interrupt the smooth action of the shaft through the bridge hand during and in preparation for a pool shot. Applicants respectfully submit that such an interruption would render the shaft of Holt inoperable and, therefore, teaches away from combining Williams and Holt. Accordingly, Williams' invention is unsuitable for use with any pool cue shaft.

Accordingly, applicants respectfully submit that the references teach away from combining Williams with any shaft. Accordingly, a prima facie case of obviousness cannot lie from the combination of Williams and Holt, and the Examiner should allow claim 8.

The Examiner cites Holt for the proposition that "it is known in the art to place marks along the cue" (OA page 6, 3rd paragraph). The examiner should appreciate the ambiguity in Holt's unsupported allusion to unreferenced prior art in that the "special designs along the cue" do not necessarily include the shaft. As is shown in the attached Exhibit 1, the word "cue" is commonly used to refer to the butt portion of a pool cue stick. A plethora of similar exhibits can be found on the internet. Accordingly, the Examiner has not shown that Holt intended to refer to the shaft of the pool cue in the cited lines. Therefore, a prima facie case of obviousness has not been presented in the combination of Williams and Holt, and the Examiner should allow claim 8.

None of the art referenced by Holt on the cover page of Holt's patent shows cue shafts with markings on the shaft. One of the references does show a luminescent ferrule. The Examiner should be aware of the danger in using unsubstantiated background remarks from a patent as prior art. If such statements are used, any patent writer can insert unsubstantiated, careless, or even irresponsible statements in the background section of a patent, and thereby restrict all future development in the art. Williams' unsupported statement is not the art of Williams. If such art exists, the Examiner should show it.

Holt himself teaches away from predetermined distances from the ferrule-receiving portion: "Transparent section 50 preferably ends at tip 56, however, transparent section need not extend so far and could be joined to an opaque section before tip 56." (Holt, Col 4, lines 13-16). Applicants respectfully submit that Holt is teaching that the transparent section may be of any extent, may have no distance between the tip and the transparent section, and that extension is measured from the base end of the shaft. Applicants respectfully submit that the Examiner has not shown that Holt relates the distance to any game parameter. Accordingly, a prima facie case of obviousness cannot lie from the combination of Williams and Holt and the Examiner should allow claim 8.

Applicants respectfully submit that, in response to applicants raising the issue of reasonable expectation of success, the Examiner did not show a reasonable expectation of success for combining Williams' pool cue butt label holder apparatus (which does not conform to the circumferential curvature of the pool cue butt) with Holt's illuminated pool cue apparatus in the Final Office Action and so the Examiner has conceded the point. For the reasons discussed above, no person of ordinary skill in the art of making pool cue shafts would expect success from combining Williams with a pool cue shaft, including Holt's shaft. A person of skill in the art would not expect success from combining Williams and Holt where neither expressly teaches trademarks nor that "said at least one predetermined distance has a relationship to at least one game parameter" (App. Claim 1). Furthermore, a person of skill in the art faced with the problems applicants have solved and with the application of Williams and patent of Holt before him would not think to combine such incompatible arts. Accordingly, a prima facie case of obviousness cannot lie, and the Examiner should allow claim 8.

Applicants respectfully submit that, in response to applicants raising the issue that the references did not teach or suggest all the claim limitations, the Examiner did not demonstrate that the combination of Holt and Williams taught or suggested all claim limitations and so concedes the point. Accordingly, a prima facie case of obviousness cannot lie, and the Examiner should allow claim 8. While the Examiner asserts that he cites Williams and Holt for only limited portions of their disclosure (FOA, page 3, last paragraph, lines 3-5), the Examiner has not cited where in Williams and Holt the Examiner has found alleged disclosures of each element of applicants' claims and

Request for Withdrawal of Final Office Action and, in the Alternative, Response to Final Office Action

diligent effort by applicants' attorney has not found them. Applicants respectfully submit that Holt does not teach or suggest that "said at least one predetermined distance has a relationship to at least one game parameter" (App. Claim 1, included in Claim 8). Applicants respectfully submit that the words "predetermined", "stroke", "speed", "bridge", "hand", "location", and "parameter" are not found in Holt and only non-relevant uses of "game" and "distance" are found in Holt. Applicants respectfully submit that Holt does not teach or suggest predetermined distances (Holt, Col. 4, lines 13-16). Applicants respectfully submit that Holt teaches pride through illumination (Holt, Col. 1, lines 22-25), implying a whimsical basis for design, rather than a "predetermined distance" having "a relationship to at least one game parameter" (App. Claim 1, included in Claim 8). Applicants respectfully submit that Holt does not teach or suggest game parameters. Applicants respectfully submit that Holt does not teach or suggest a relationship between the untaught predetermined distances and the untaught game parameters. Holt does not teach or suggest placing trademarks on pool cue shafts. Therefore, the combination of Holt and Williams would not provide all elements of applicants' claim 8. Accordingly, applicants respectfully request that the Examiner allow claim 8.

Applicants respectfully suggest that the Examiner's analysis uses impermissible hindsight where the Examiner superimposes elements of applicants' claims onto the references. For example, Williams does not teach or suggest trademark icons as applicants do, but the Examiner superimposes applicants' disclosed trademarks onto the art of Williams, who teaches away from trademarks. Holt does not teach or suggest a relationship between gaming parameters and predetermined distances between icons and the ferrule-receiving portion of the shaft but the Examiner superimposes applicants' disclosed predetermined distances onto the art of Holt. Applicants respectfully suggest that the Examiner has interpreted the word "predetermined" to have no meaning, which is contrary to correct procedure (MPEP 2111.01). Applicants respectfully request that the Examiner clearly state the meaning he has given to "predetermined."

For all of the reasons given above or because claim 8 is dependent from allowable claim 1, Applicants respectfully request that the Examiner allow claim 8.

Application No. 10/949,868

Request for Withdrawal of Final Office Action and, in the Alternative, Response to Final Office Action

Remarks

Applicants have amended claim 5 to more clearly delineate applicants' claimed invention. Claim 21 has been withdrawn due to election. Applicants have added new claims 22-31 to emphasize various aspects of applicants' claimed invention. Independent claims 22 and 27 are variants of claim 1 and the dependent claims 23-26 and 28-31 are variants of existing dependent claims. Claim 22 narrows "game parameter" to "at least one of stroke length, stroke speed, and bridge hand location." Claim 27 further limits the icon to an inlaid icon and clarifies that the predetermined distance related to a game parameter is determined before the icon location is fixed. Claim 32 is a dependent claim for a particular embodiment.

In light of the Examiner's restriction requirement, Applicants reserve the right to present the non-elected claims in a divisional application.

Should any fees be due as a result of this Office Action Response, please advise the undersigned promptly.

If the Examiner believes that prosecution of this matter would be expedited by a telephonic conference with Applicant's attorney, please call 480 390-6179.

Respectfully submitted,

KEITH L. JENKINS, REGISTERED PATENT ATTORNEY

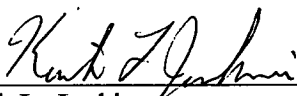
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EXHIBIT 1

[Home](#) > [Pool Cues](#) > [Sterling Pool Cues](#) > [Artistic Pool Cues](#)

Artistic Pool Cues

These Sterling pool cues feature attractive designs at attractive prices. Check out the beautiful wood used in the White Diamonds cue, and the recreation of detail in the Ginacue tribute. You will be very pleased with the excellent value these cues bring.



Sterling "White Diamonds" Pool Cue

Sterling "White Diamonds" Pool Cue
STARPD Regular price: \$99.00 Sale price: \$79.20

weight:



Sterling "Santa Fe" Pool Cue

Sterling "Santa Fe" Pool Cue
STARPT Regular price: \$99.00 Sale price: \$79.20

weight:



Sterling "Gina" Pool Cue

Sterling "Gina" Pool Cue
STARGC Regular price: \$99.00 Sale price: \$79.20

weight:



Sterling "Black on White" Pool Cue

Sterling "Black on White" Pool Cue
STARBW Regular price: \$99.00 Sale price: \$79.20

weight:



Sterling "Chevron" Pool Cue

Sterling "Chevron" Pool Cue
STARBC Regular price: \$99.00 Sale price: \$79.20

weight:

<http://www.cuesight.com/pool-cues-sterling-artistic-pool-cues.html>